

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Improper Rejections

As an initial matter, Applicant respectfully notes that the rejections made by the Examiner in the Office Action mailed on October 2, 2006 were not in accordance with 37 C.F.R. 1.104 (c)(2):

In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

When rejecting claims 1-2, 5, and 7-10 under 35 U.S.C. § 102(e) in the present Office Action (p. 2, § 3), the Examiner simply copies claims 1 and 9-10 of the present application, and asserts that the cited reference discloses all of claims 1 and 9-10 without providing any specific designations of the corresponding elements in the cited reference. In particular, the part of the reference the Examiner refers to (pp. [0029]-[0066]) includes almost the entire specification.

When rejecting claims 4 and 6 under 35 U.S.C. § 103(a) in the Office Action mailed on October 2, 2006 (p. 6, § 6), the Examiner again refers to a part of a reference (p. 2, line 31 to p. 3, line 30) spanning more than one full page, and asserts that the cited part discloses a single feature without reasonable specificity.

In view of the above, the Applicant respectfully requests the Examiner to withdraw the non-final office action mailed on October 2, 2006, and re-issue a new non-final office action, which includes rejections in accordance with 37 C.F.R. 1.104 (c)(2). Notwithstanding the above request, the Applicant responds to non-final office action mailed on October 2, 2006, as follows.

Disposition of Claims

Claims 1-10 are currently pending in this application. Claims 1 and 8-10 are independent. The remaining claims depend, directly or indirectly, from claim 1.

Rejection(s) under 35 U.S.C § 102

Claims 1-2, 5, and 7-10 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Application Publication No. 20040235467 ("Tuilier"). For the reasons set forth below, the rejection is respectfully traversed.

The following is an example of an embodiment of the invention. The following example is not intended to limit the scope of the claims. Turning to the example, Figures 2-3 illustrate the communication steps involved between an old SIM card (SCA), a new SIM card (SCB), and an application server (AS) configured to communicate with various network elements (NLT). Each SIM card (SCA & SCB) includes parameters that the application server (AS) recognizes as assigned to a particular mobile number. For example, the SCA may include identifying parameters A1 and A2 assigned to mobile #A, and the SCB may include identifying parameters B1 and B2 assigned to mobile #B. In particular, this embodiment may improve the activation process in instances where an existing subscriber seeks to replace his current SIM card with a new SIM card, but wishes to retain his old mobile number. (*see* Published Specification, pp. [0037]-[0051].

Initially, while the old SIM card (SCA) is still embedded in the subscriber's mobile and prior to inserting the new SIM card (SCB), the subscriber may first send a text message (SMS) to application server (AS). The SMS may include the identification information for new mobile #B assigned to new SIM card (SCB), thus enabling application server (AS) to store mobile #B for later use. To that end, the aforementioned SMS flows in one direction (*i.e.*, from mobile phone directly to application server). During a later step, the application server (AS) may send an encrypted SMS to the old SIM card (SCA) for removing the parameters A1 and A2 that identify SCA with the old mobile #A. Subsequently, the subscriber may be instructed via SMS to remove old card (SCA) and insert new card (SCB). After insertion of new card (SCB), the Application Server (AS) sends an encrypted SMS using the previously stored mobile #B to the new card (SCB). In this embodiment, the encrypted SMS may update the parameters on the new card SCB with the old parameters from old card SCA (*i.e.* replaces B1 and B2 with A1 and A2), resulting in the *new card assigned to the old phone #A*. Said another way, now that new card SCB includes parameters A1 and A2, the application server (AS) recognizes these parameters A1 and A2 as assigned to mobile #A, and thus, subscriber has a new SIM card (SCB) while using his old mobile #A. Accordingly, the aforementioned embodiment encompasses *direct communication* between the subscriber's mobile phone and the application server. Further, the present embodiment advantageously eliminates the manual intervention on the part of a GSM operator, allowing a single subscriber to complete the activation process. (*see* Published Specification, pp. [0037]-[0051]).

Turning to the rejection, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

1053 (Fed. Cir. 1987). (See MPEP § 2131). The Applicant respectfully asserts that Tuilier fails to disclose all the limitations of independent claims 1 and 8-10.

In particular, independent claim 1 requires, *inter alia*, “A method for managing phone numbers attribution after replacement of a first portable object (SCA) by a second portable object (SCB)...[comprising]...a second sending step, in which an *application server (AS)* sends a message (*M2*) for replacing, in the second portable object (SCB), the *second identification data (IMSIB, ADMB, KiB)* by the *first identification data (IMSIA, ADMA, KiA)* attached to the first phone number (*MSISDNA*).” Tuilier is completely silent with respect to the aforementioned limitation as recited in independent claim 1.

Rather, Tuilier is directed to a method for updating personal information files (*e.g.*, a mobile phone directory) via a local terminal in the mobile phones of a subscriber’s correspondents (*i.e.* friends and family). Said another way, after a subscriber has changed phone numbers as a result of a new SIM card, Tuilier discloses a method for *dispatching the subscriber’s new phone number to multiple contacts* listed in his mobile phone directory. For example, a subscriber, as disclosed by Tuilier, who wishes to replace his old SIM card but retain personal files (*i.e.*, a phone directory), must *physically bring the mobile to a human operator* to facilitate the change, a step that may be eliminated by one or more embodiments of the present invention. Specifically, the human operator updates the new SIM card with the directory file from the old SIM card, and *does not update it with the old phone number*. (*see* Tuilier, pp. [0029]-[0036]).

Further, the subscriber’s new phone number is dispatched by the operator to the subscriber’s friends and *replaces the old phone number*, thus the new number is kept in tact. To that end, even assuming *arguendo* that the old number was replacing the new number, replacement, as disclosed by Tuilier, occurs inside mobile phones belonging to subscriber’s

friends *instead of in the subscriber's phone* where the newly inserted SIM card is located. Thus, Tuilier fails to disclose replacing, in the second portable object [new SIM card], the second identification data by the first identification data. (*see* Tuilier, pp. [0047]).

Moreover, independent claim 1 also requires, "...a first sending step, in which the *communication device (CD) sends to an application server (AS)* a message including a second identification data identifying a second phone number (MSISDNB) assigned to the second portable object (SCB)." Tuilier is completely silent with respect to the aforementioned limitation as recited in independent claim 1.

As discussed previously, Tuilier discloses a human operator initiated updating of multiple phonebooks in multiple mobile phones belonging to contacts listed in a subscriber's directory. The human operator sends a text message (SMS) through a network to the contacts listed in the subscriber's phonebook, which includes the subscriber's new phone number. Furthermore, any updating of information in *the subscriber's phone* is facilitated by the intervention of a human operator and *not an application server*. To that end, Tuilier only discloses an SMS (*i.e., a text message* containing the new number information) sent *from the operator to multiple mobile phones*, for updating the phones owned by the subscriber's correspondents. Thus, these teachings of Tuilier fail to disclose the claimed invention as (i) the direction of communication disclosed in Tuilier is opposite of the direction of communication between two endpoints required by independent claim 1 and (ii) Tuilier fails to disclose both endpoints of the communication (*i.e. communication device and application server*). Accordingly, the SMS, as disclosed by Tuilier, is simply a mechanism to (i) notify the subscriber's friends of his new number and (ii) to dispatch out the new number, period.

In view of the above, Tuilier fails to disclose all the limitations recited in independent claim 1. Thus, independent claim 1 is patentable over Tuilier. Independent claims 8-10 are

believed to include at least the same patentable limitations as independent claim 1 and thus, are patentable over Tuilier for at least the same reasons as independent claim 1. Further, dependant claims are patentable over Tuilier for at least the same reasons as independent claim 1. Thus, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuilier in view of U.S. Patent Application Publication No. 2005075137 (“Reemtsma”). Claim 3 depends directly from independent claim 1. To the extent that this rejection applies to independent claim 1, the rejection is respectfully traversed.

“To establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (See MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (See MPEP §2143.03). The Applicant respectfully asserts that the cited references, whether considered separately or in combination, fail to teach or suggest all the limitations of independent claim 1.

As discussed previously, Tuilier does not teach or suggest all the limitations of independent claim 1. Further, Reemtsma does not teach that which Tuilier lacks. This is evidenced by the fact that Reemtsma is only relied upon to teach “a first sending step where the application server sends a secure message for deleting the first identification data,” (*see* Office Action mailed October 2, 2006 at p. 5). Reemtsma is directed to a method for simplifying the exchange of a SIM card of subscribers for a digital mobile communications network. Reemtsma is completely silent with respect to an application server sending a message including a second identification data identifying a second phone number; and sending a message for replacing the

second identification data by the first identification data attached to the first phone number. Accordingly, independent claim 1 is patentable over Tuilier and Reemtsma. Dependent claim 3 is patentable for at least the same reasons. Thus, withdrawal of this rejection is respectfully requested.

Claims 4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuilier in view of Reemtsma and further in view of International Application Publication No. WO 98/56201 (“Oy”). Claims 4 and 6 depend, directly or indirectly, from independent claim 1. To the extent that this rejection applies to independent claim 1, the rejection is respectfully traversed.

As discussed previously, Tuilier and Reemtsma, whether considered separately or in combination, fail to teach or suggest all the limitations of independent claim 1 and dependent claim 3. Further, Oy does not teach that which Tuilier and Reemtsma lack. This is evidenced by the fact that Oy is only relied upon to teach “a method wherein the secure message is encrypted,” (see Office Action mailed October 2, 2006 at p. 6). Oy is directed to a method for controlling a SIM card in a mobile telephone network. Oy is completely silent with respect to an application server sending a message including a second identification data identifying a second phone number; and sending a message for replacing the second identification data by the first identification data attached to the first phone number. Accordingly, independent claim 1 is patentable over Tuilier, Reemtsma, and Oy. Dependent claims 4 and 6 are patentable for at least the same reasons. Thus, withdrawal of this rejection is respectfully requested.

Further, even assuming *arguendo* that the aforementioned limitations are taught or suggested by the cited references, the Applicant respectfully asserts that Tuilier may not be used to establish a *prima facie* case of obviousness. Specifically, Tuilier teaches away from “replacing the second identification data by the first identification data attached to the first phone

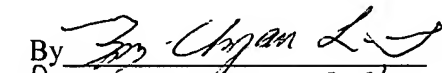
number” (*i.e.* retaining the old mobile phone number on the new SIM card). Specifically, Tuilier states that “when a subscriber...change[s] SIM card...his call number is modified...and the directories of the correspondent are no longer up to date...[and thus, an] aim of the invention is to implement a method for updating the personal data files of the correspondents...” (*see* Tuilier, pp. [0003] and [0005]. Clearly, from the above statement, Tuilier teaches away from retaining the old mobile number as the invention disclosed by Tuilier is geared toward the case when the *phone number must be changed* due to a new SIM card. In view of the above, it is improper to combine Tuilier with any cited reference to establish a *prima facie* case of obviousness. Accordingly, dependent claims 3-4 and 6 are patentable over Tuilier, Reemtsma, and Oy. Accordingly, withdrawal of these rejections are respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/064001).

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Respectfully submitted,

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